

REMARKS

In the Office Action mailed October 14, 2005, the Examiner rejected claims 1-10, 26-43, 60-66, and 72-78 under 35 U.S.C. § 103(a) as being patentable over *Marshall* ("ZAP-The Computer Lops Off Another Bad Risk," United States Banker).¹

Based on the following arguments, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §103(a).

I. The Rejections Under 35 U.S.C. § 103(a)

Applicants traverse the rejection of claims 1-10, 26-43, 60-66, and 72-78 under 35 U.S.C. § 103(a) because a case for *prima facie* obviousness has not been established based on *Marshall*. As M.P.E.P. § 2142 states, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." To establish *prima facie* obviousness under 35 U.S.C. § 103(a), three requirements must be met. First, the applied references, taken alone or in combination, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the reference(s) or in the knowledge generally available to one of ordinary skill in the art, to combine or modify the reference(s) in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether or not any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

the prior art, and not be based on applicant's disclosure." M.P.E.P. § 2143 (8th ed. 2001).

The Examiner asserts *Marshall* teaches presenting an offer for an extra credit line to each customer. The Examiner, however, admits *Marshall* does not teach processing responses to the offers and activating at least one extra line of credit to the existing credit card account of each responding customer and notifying each customer who has responded to the offer of an activated status of the at least one extra credit line. (Office Action at page 3) Nonetheless, the Examiner asserts without support, that it would have been obvious to modify *Marshall* to include the recitations of claim 1 because "customers usually receive . . . credit cards by mail [with a letter that] instructs the customers to activate credit cards by calling the toll free numbers of the credit card company," and "in the existing credit card system, customers usually receive the credit card [which] statements include[d] credit limits, outstanding balances, interest applied, purchase histories, special offers, etc." (OA at 3.) As further explained below, the Examiner's conclusions are conjecture and do not establish a *prima facie* case of obviousness.

A. *Marshall* Does Not Teach or Suggest Presenting an Offer for an Extra Credit Line to Each Customer in the Target Customer Group

Contrary to the Examiner's assertions, *Marshall* does not teach or even suggest an offer for an extra credit line, much less presenting such an offer to customer in a target customer group who holds an existing credit card account issued by a credit card issuer. Instead, as noted by the Examiner, *Marshall*

merely states, "USAA Federal Savings Bank in San Antonio applied adaptive control to raise credit limits automatically on good customers in its military affinity card group." Raising a credit limit, however, is not the same as an offer for an *extra credit line*, as recited in claim 1. A credit limit reflects the spending power of a credit card (i.e., the maximum amount of funds that is financed to the cardholder for making purchases) and is typically limited to a particular amount that is predetermined by the issuer of the card. A credit limit is associated with a credit line, and thus may be considered, for example, an attribute of a credit line. That is, a credit line may have a certain credit limit. Accordingly, Marshall's mere description of a bank automatically raising credit limits to good customers does not show presenting an offer for an extra credit line to each customer in the target customer group, as recited in claim 1. Therefore, for at least this reason, the Examiner has not established a *prima facie* case of obviousness in rejecting this claim.

B. The Examiner's Conclusion That the Claimed Features Missing From *Marshall* are Well Known in the Art are Conjecture and Does Not Address the Claimed Features

The Examiner apparently takes official notice that the features missing from *Marshall* (as asserted by the Examiner) are well known in the art. As noted in M.P.E.P. § 2144.03(A),

[o]fficial notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known,

or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. . . . It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697 ("[T]he Board cannot simply reach conclusions based on its own understanding or experience-or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.").

Further, M.P.E.P. § 2144.03(B), states,

[o]rdinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection). . . . The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.

Here, the Examiner asserts it is well known in the art that customers usually receive a letter with a credit card that instructs the customer to activate the card by calling a toll free number. (OA at 3.) The Examiner, however, provides no substantial evidence of the examples. Moreover, the exemplary process does not even address all of the recitations of claim 1, which requires, among other things,

processing responses to the offers from customers in the target customer group and ***activating at least one extra line of credit to the existing credit card***

account of each customer that has responded to the offer for extra credit.

(Emphasis added.) The Examiner's hypothetical example presented in the Office Action merely describes an environment where a customer may receive a new credit card that is to be activated by the customer. In contrast, claim 1 recites steps that include, for example, activating at least one extra line of credit to an existing credit card account, and notifying each customer who responds to the extra credit offer of an activated status of the at least one extra credit line. In the Examiner's example, only one account is associated with the *new* credit card sent to the customer, which is different from claim 1.

Claim 1 further requires, among other things,

notifying each customer who has responded to the extra credit offer ***of an activated status of the at least one extra credit line*** associated with the customer's credit card account.

(Emphasis added). The Examiner's example of a customer receiving credit card statements including credit limits, balances, interest charges, purchase histories, special offers, etc. does not address at least the above claimed features. (OA at 3.) Instead, the Examiner merely describes receiving a statement for a single credit card account, which does not meet the recitations of claim 1. Accordingly, for these additional reasons, the Examiner has not established a *prima facie* case of obviousness in rejecting claim 1. Applicants therefore request that the rejection of this claim be withdrawn, and the claim allowed.

Claims 2-10 depend from claim 1. As explained, *Marshall* does not support the rejection of claim 1. Accordingly, *Marshall* also does not support the rejection of claims 2-10 for at least the same reasons set forth above in

connection with claim 1. Further, the Examiner's allegations of obviousness is conjecture and does not even make up for the deficiencies of *Marshall*.

Therefore, Applicants request the rejection of claims 2-10 be withdrawn and the claims allowed.

The Examiner rejects claims 26-33 and 60-66 for the same reasons as claims 1-10. (OA at 6.) Claims 26-33 and 60-66, however, include recitations different from those of claims 1-10. In any event, the Examiner has not established a *prima facie* case of obviousness. For claims 1-10, the Examiner has not established a *prima facie* case for claims 26-33 and 60-66. Further, insomuch as there are similarities between claims 1-10 and 26-33, 60-66, Applicants submit claims 26-33 and 60-66 are distinguishable from the cited art for at least the same reasons set forth above in connection with claims 1-10. Therefore, Applicants request the rejection of these claims be withdrawn and the claims allowed.

The Examiner rejects claims 34-43 for the same reasons as claims 1-10. (OA at 6.) Accordingly, Applicants submit claims 34-43 are distinguishable from the cited art for at least the same reasons set forth above in connection with claims 1-10. Therefore, Applicants request the rejection of claims 34-43 be withdrawn and the claims allowed.

The Examiner rejects claims 72-78 for the same reasons as claims 1, 2, and 6-10. (OA at 6.) Applicants submit claims 72-78 are distinguishable from the cited art for at least the same reasons set forth above in connection with

claims 1, 2, and 6-10. Therefore, Applicants request the rejection of claims 72-78 be withdrawn and the claims allowed.

II. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account no. 06-0916.

Respectfully submitted,

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Dated: January 13, 2006

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